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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,877	08/18/2003	Christian Wamprecht	Mo6800N/LeA 34,848N	3372
157	7590	03/31/2005	EXAMINER	
BAYER MATERIAL SCIENCE LLC			NILAND, PATRICK DENNIS	
100 BAYER ROAD			ART UNIT	PAPER NUMBER
PITTSBURGH, PA 15205			1714	

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/642,877

Applicant(s)

WAMPRECHT ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8 and 17-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8 and 17-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 10/091960.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 8 and 17-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6642302 Wamprecht et al.. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are identical where component D is the oxime. This is an obviousness type double patenting only because of the scope difference in the claims.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8, 17-22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/30425 Martz et al..

Martz et al. discloses aqueous polyurethane emulsifiers which are the reaction product of polyether polyols, polyisocyanates, diamines (page 4, lines 22-25 noting "and combinations thereof" and page 5, lines 11-17), and alcohols falling within the scope of the instantly claimed

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component B (page 4, line 27) of claims 8, 19-21 and 23. Where the polyether polyol of Martz has 3 or more OH groups (page 4, lines 14-15), it reads on component a1 of the instant claims 8, 17-18, and 23-25. Statistically, two of these polyether polyols will be joined by a diisocyanate in the final polyurethane of the reference. This creates a tetrol polyurethane polyether moiety within the polyurethane of Martz, which if hydrolyzed from the polyurethane of Martz would read on the instantly claimed component a2. Since the instant claims are directed to the final polyurethane, it is immaterial how this moiety got into the polyurethane of Martz as such a combination of polyether triol moieties and polyether urethane tetrol moieties would be indistinguishable from the moieties placed into the instantly claimed polyurethane molecules by the instantly claimed component A. Thus, Martz encompasses the instantly claimed component A being within the final polyurethane, which is the subject of the instant claims. Page 2, line 28 to page 3, line 8 falls within the scope of the instantly claimed starting NCO/OH ratio. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the above discussed combinations of ingredients in the polyurethane of Martz because they are encompassed by Martz and would have been expected to give the properties of the polyurethane of Martz to the final paint compositions. See the entire document.

5. Claims 8, 17-22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5023309 Kruse et al..

Kruse et al. discloses aqueous polyurethane thickeners which are the reaction product of polyether polyols, polyisocyanates, diamines (column 8, lines 40-46 ), and alcohols falling within the scope of the instantly claimed component B (column 10, line 34 et seq and column 11, lines 1-4) of claims 8, 19-21 and 23. Where the polyether polyol of Kruse has 3 or more OH

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groups (column 5, lines 38-68 and column 6, lines 1-5), it reads on component a1 of the instant claims 8, 17-18, and 23-25. Statistically, two of these polyether polyols will be joined by a diisocyanate in the final polyurethane of the reference. This creates a tetrol polyurethane polyether moiety within the polyurethane of Kruse, which if hydrolyzed from the polyurethane of Kruse would read on the instantly claimed component a2. Since the instant claims are directed to the final polyurethane, it is immaterial how this moiety got into the polyurethane of Kruse as such a combination of polyether triol moieties and polyether urethane tetrol moieties would be indistinguishable from the moieties placed into the instantly claimed polyurethane molecules by the instantly claimed component A. Thus, Kruse encompasses the instantly claimed component A being within the final polyurethane, which is the subject of the instant claims. Column 5, lines 38-43, column 6, lines 40-46, and column 10, lines 25-37 falls within the scope of the instantly claimed starting NCO/OH ratio. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the above discussed combinations of ingredients in the polyurethane of Kruse because they are encompassed by Kruse and would have been expected to give the properties of the polyurethane of Kruse to the final compositions of column 15, lines 49-55.

6. Claims 23-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


The cited prior art does not disclose making the claimed product by the claimed method, particularly using the mixture of reactants of component A nor provide rationale for doing so.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Patrick D. Niland  
Primary Examiner  
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